



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,057	10/06/2000	Stefan Johansson	15292.2	1607

7590 04/26/2005

Attn: DANA L. TANGREN
WORKMAN, NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

EDELMAN, BRADLEY E

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,057

Applicant(s)

JOHANSSON, STEFAN

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to Applicant's amendments and request for reconsideration filed on January 5, 2005. Claims 1-30 are presented for further examination. Claims 31-34 have been withdrawn from consideration as being directed toward the non-elected invention.

Specification

As a result of Applicant's amendments to the specification, the previous objections to the specification have been withdrawn.

Drawings

In response to Applicant's amendment to the drawings, the previous objections to the drawings have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2153

1. Claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Winbladh (U.S. Patent No. 6,205,330).

In considering claim 1, Winbladh discloses a method for initiating immediate transfer of packet data from a network server ("server 11") to a mobile communication station ("MS unit 20" coupled to "PC 22") over a digital radio communication network ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52, describing the use of the system in a data packet network; col. 6, lines 18-44, describing use over a TCP/IP system), including the acts of:

Sending a message to the mobile communication station using a message service provided by the digital radio communication network ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8), said message including a first packet data network address of said network server (col. 7, lines 7-8, 32-35, "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored");

Extracting the first packet data network address from the message by way of an application executing on the mobile communication station (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Establishing, from the application of the mobile communication station having a second packet data network address (the computer unit 22 necessarily has a second packet data network address to set up the session), a packet data protocol session with

Art Unit: 2153

said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)");

Whereby the network server is able to transfer packet data to the mobile communication station and the application using said packet data protocol session (col. 7, lines 63-67, "[server 11] commences the transmission of data in the same session").

In considering claim 2, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 3, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 4, Winbladh further discloses that the application performs the act of identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends the its number and a password to the server).

In considering claim 9, Winbladh further discloses that the application performs:

Examining an activation code present in the message received by the mobile communication station (col. 8, lines 55-56, "activation code [is] sent from the server 11 via an SMS"); and

Performing said act of identifying the mobile communication station to the radio communication network only if an appropriate activation was found in the message during the examining act (col. 8, lines 62-65, "manual insertion of the obtained code via the activation window activates the communications software 46 for the possibility of sending and receiving e-mail," or col. 9, lines 1-3, wherein activation is automatic).

In considering claim 10, Winbladh further discloses that the application performs:

Examining a service indication field ("field 'Code' 43," col. 7, lines 29-30); and

Presenting a message to a user of the mobile communication station the message being based on the content of the service indication field and describing the service that will be initiated (col. 8, line 62 – col. 9, line 8, wherein a "PIN code" is additionally entered by the mobile user to activate the service).

In considering claim 11, Winbladh further discloses that the message is a text message (col. 8, lines 54-55).

In considering claim 12, Winbladh further discloses that the application further performs the acts of:

Waiting for a reply to the presented message from the user of the mobile communication station (col. 8, lines 54-55, waiting for the user to enter the code); and

Continuing with, or aborting, said act of identifying the mobile communication station to the digital radio communication network in dependence on the reply to the presented message (col. 8, lines 56-57, wherein registration is confirmed if the correct code is entered).

In considering claim 13, Winbladh further discloses that the reply comprises an accept or deny reply (i.e. correct confirmation is an accept reply, and incorrect confirmation is a deny reply).

In considering claim 16, Winbladh discloses a system at a mobile communication station ("MS unit 20" coupled to "PC 22") for facilitating immediate transfer of packet data from a network server ("server 11") to a mobile communication station over a digital radio communication network ("GSM" network), including:

First receiving means for receiving a message from a message service provided by the digital radio communication network, the message including a first packet data network address of said network server ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8; wherein the "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored," col. 7, lines 7-8, 32-35);

Art Unit: 2153

Extracting means for extracting the first packet data network address from the message (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Packet data protocol means for establishing a packet data protocol session ("session") with said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)"), and for receiving packet data from the network server addressed to a second packet data network address, which second packet data network address is allocated to the mobile communication station (col. 8, lines 53-61, wherein during the session, e-mails and other information are sent to the mobile station, which necessarily has a packet data network address since it is part of the packet data network).

In considering claim 17, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 18, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 19, Winbladh further discloses means for identifying the mobile communication station to the packet data service part of the digital radio

Art Unit: 2153

communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 24, claim 24 presents a program storage device for performing the same steps as the arrangement of claim 16, and is thus rejected for the same reasons.

In considering claim 25, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 27, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 28, Winbladh further discloses the program storage device performing the act of causing the mobile communication station to identify itself to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-8, 14, 15, 20-23, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winbladh, in view of Lager et al. (U.S. Patent No. 6,636,502, hereinafter "Lager").

In considering claims 5, 20, and 29, Winbladh further discloses that the step of identifying the mobile station to the packet data service of the digital communication network comprises an attach step if the device is not already attached (col. 8, lines 23-30, wherein if it is a new session, the mobile device sends its ID, a password, and other information to the service to identify itself). However, Winbladh does not disclose that the attach is a GPRS attach. Nonetheless, the inclusion of a GPRS system, including a GPRS attach within a GSM network is well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that allows a mobile device to set up a session with a network service, including a means for allowing the mobile device to attach to the network, wherein the system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh, because GPRS provides more effective use of

Art Unit: 2153

scarce resources (see Lager, col. 1, lines 22-26). Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh.

Claim 26 also describes that the GSM system uses GPRS, and is thus rejected under the same rationale as claims 5, 20, and 29.

In considering claims 6, 21, and 30, Winbladh discloses the claimed activation step of sending a request from the application to the network to activate a packet data service for the mobile communication station if the station does not have such a packet data service activated (col. 8, lines 23-34). However, Winbladh does not disclose the claimed steps of allocating a temporary network address as part of the activation step to the mobile communication station, wherein the temporary network address becomes the address used by the station for the station. That is because Winbladh remains silent regarding how the address is allocated to the mobile communication station.

Nonetheless, the GPRS system taught by Lager actually uses a temporary address assignment scheme. See Lager, col. 3, lines 46-57; col. 8, lines 6-30. It is advantageous to use temporary addresses for mobile devices in a GSM network, because temporary addressing allows for a larger number of systems to connect to the network. Therefore, it would have been obvious to use the temporary address assignment scheme taught by Lager to improve the scalability of the system taught by Winbladh.

In considering claims 7 and 22, Lager further teaches using GPRS Packet Data Protocol Context activation as the activation request (col. 3, lines 58-65; col. 6, lines 30-35; col. 8, lines 6-20).

In considering claims 8 and 23, Lager further discloses that the temporary network address is an IP address (col. 8, lines 6-20).

In considering claim 14, Lager further discloses the claimed ciphering step (col. 6, lines 10-20). It would have been obvious to include this in the system taught by Winbladh and Lager, in order to improve the security of the system.

In considering claim 15, Lager further discloses that the identification number associated with the mobile station is a MS-ISDN number (col. 3, lines 21-22).

Response to Arguments

Applicant's arguments filed on January 5, 2005 have been fully considered but they are not persuasive. Applicant has argued the following:

- a. Winbladh does not teach, suggest, or enable a method for initiating immediate transfer of packet data from a network server to a mobile communication station over a digital radio communication network, which includes establishing, from the application of the mobile communication station having a second packet data network address, a packet data protocol session with said network server using said first packet data

Art Unit: 2153

network address, whereby the network server is able to transfer packet data to the mobile communication station and the application using said packet data protocol session, as claimed in claim 1.

Applicant further argues that the similar claim language of claims 16 and 24 likewise is not taught, suggested, or enabled by Winbladh.

Applicant's primary reasoning in support of this argument is that the claim requires a "mobile communication station," to perform the claimed steps, but the Winbladh system uses software (labeled "software 46" and "software 49") within the "computer 22" to perform the claimed steps, and not the "MS Unit 20." Examiner respectfully disagrees with this argument. Notably, the term "mobile communication station" is a broad term that is not limited to any individual unit. In the Winbladh system, the combined "MS Unit 20" and "PC 22" work together to achieve the steps of the claimed invention. Therefore, Examiner has interpreted the combined "MS Unit 20" and "PC 22" as comprising the claimed "mobile communication station." This is a reasonable interpretation given that Winbladh describes that the MS Unit 20 and PC 22 are connected via an I/O port (col. 4, lines 65-66), further describes that the software on the PC 22 is used to process the SMS messages received by the MS Unit 20 (col. 7, lines 36-39), and ultimately teaches that the two devices are used in tandem to establish a server-initiated session in response to receiving an SMS message (as described in the claim rejections above). Given this interpretation, Winbladh teaches that a "mobile communication station" performs the steps claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BE

April 20, 2005